

Remarks/Arguments:

The pending claims are 10-28.

Introduction

The invention claimed herein is a stent (claims 10-21) and the method of using such a stent (claims 22-28), characterized by a tubular construction, comprising a plurality of adjacent hoops that are aligned along the tubular axis. Each hoop comprises a series of elongate elements which meet one another and form vertices. At least some of the vertices axially abut and are connected to oppositely pointed vertices of an adjacent hoop. Each hoop is separate and distinct from the other hoops. There is also a graft that closes the openings of the stent structure. Claim 17 has been indicated to be directed to patentable subject matter. At this time, the Applicant has not rewritten claim 17 into independent form because he believes that parent claim 10 is allowable.

A. Summary of Pending Rejections

In the Office Action of October 21, 2003, claims 10-11, 13-15, 16, and 18-21 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,360,443 to Barone et al. in view of U.S. Patent No. 5,035,706 to Gianturco. Claim 12 was rejected under 35 U.S.C. §103(a) as unpatentable over Barone in view of Gianturco and further in view of U.S. Patent No. 4,580,568 to Gianturco. Claims 24 and 27 were rejected under 35 U.S.C. § 103(a) as unpatentable over Barone and Gianturco '706 in view of Gianturco '568 and further in view of Dotter. Figure 6 of Gianturco '706 was specifically cited and relied upon.

B. The April 14, 2004 Telephone Interview

Applicant acknowledges with thanks the courtesy shown his representative by Examiner Bui in a telephone interview on April 14, 2004.

In that interview, Applicant's attorney pointed out that the claims do not recite that the vertices are substantially aligned. Rather, the claims recite that the vertices "axially abut" and, therefore, the claims are not anticipated by the Gianturco '706 patent. In addition, Applicant's attorney pointed out, one cannot reasonably discern from the Gianturco figures that any vertices axially abut.

Applicant's attorney also urged that even if Gianturco could be interpreted in such a way as to include a showing that there are some vertices that axially abut (which Applicant's attorney expressly did not concede), any limited axial abutting (assuming for the sake of argument that there is any axial abutting at all) would constitute an accidental anticipation of that feature which, the cases hold, is not the kind of anticipation upon which the claims can be rejected.

C. The Current Request for Continued Examination

The Applicant files herewith a Request for Continued Examination pursuant to 37 C.F.R. §1.114 along with a submission. According to 37 C.F.R. §1.114(c), a submission may be in the form of new arguments in support of patentability. The arguments presented below include new arguments that constitute a proper submission under 37 C.F.R. § 1.114(c).

Each of the rejections have been based, at least in part, upon Gianturco '706. The claims do not recite that the vertices "substantially abut" as contended by the Examiner during the interview. Instead, all of the claims recite that the "vertices axially abut." Therefore, even if Gianturco '706 shows vertices that "substantially abut" (which Applicant does not concede), any such alleged substantial abutting does not support a rejection of the claims which recite that "vertices axially abut."

During the April 14, 2004 telephone interview, the Examiner also contended that Gianturco '706 has vertices that axially abut under limited conditions. Applicant does not believe that one can discern either from Gianturco's disclosure or from its figures that Gianturco's device has vertices which axially abut under limited conditions. Even if Gianturco '706 could be interpreted to show axially abutting vertices (an interpretation with which Applicant expressly disagrees), any limited axial abutting (if there is any axial abutting at all) would constitute an accidental anticipation of that feature. The cases hold, however, that "accidental results, not intended and not appreciated, do not constitute anticipation." *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U.S. 44, 66 (1923). Accordingly, since Gianturco '706 does not contain a teaching of the feature that the "vertices axially abut," and since none of the other references make up for the deficiency in Gianturco '706, there is no *prima facie* showing of obviousness.

For at least all of the above reasons, Gianturco does not disclose or suggest the invention recited in claim 10 or the invention recited in claim 22 which incorporates claim 10. All other claims are dependent on these claims and all other claims should therefore be allowable. That is, Applicant submits that the claims are not subject to rejection under 35 U.S.C. § 103(a) for any of the reasons stated in the final Office Action dated October 21, 2003.

D. Request for Suspension

Applicant has concurrently submitted a request for a three month suspension pursuant to 37 C.F.R. § 1.103(c). Applicant has requested a suspension of prosecution in order to consider the presentation of a more detailed Response and Request for Reconsideration, including additional citations of cases, in support of their argument that accidental anticipation cannot be a basis upon which the claims can be rejected. In addition, Applicant will consider whether or not to file a Rule 132 declaration.

E. Summary

For all of the foregoing reasons, Applicant's attorneys thank the Examiner for his time and Applicant again requests reconsideration of the rejections based upon the above new arguments. Applicant contends that all pending claims are in condition for allowance and early notification thereof is respectfully requested. The Examiner is requested to call one of Applicant's undersigned attorneys if any question remains or if it appears that some further amendment is necessary for allowance.

Respectfully submitted,

Joshua L. Cohen

Joshua L. Cohen, Reg. No. 38,040
Stanley Weinberg, Reg. No. 25,276
Attorneys for Applicant

SW/pb

Dated: April 21, 2004

- | |
|--|
| <input checked="" type="checkbox"/> P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700 |
| <input type="checkbox"/> P.O. Box 1596
Wilmington, DE 19899
(302) 778-2500 |

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

April 21, 2004
Joshua L. Cohen